



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,006	01/14/2005	Olivier J Poncelet	84230JJH	4921
1333 7590 04/30/2009 EASTMAN KODAK COMPANY PATENT LEGAL STAFF 343 STATE STREET ROCHESTER, NY 14650-2201			EXAMINER JOY, DAVID J	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			04/30/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ADVISORY ACTION

Response to Applicant's Remarks/Arguments

1. Applicant argues that Liu (the U.S. Patent of Liu et al., 6,548,149) does not teach the use of an aluminosilicate polymer that is identical to the polymer obtained by the specified preparation method that is presently claimed, and thus clearly does not anticipate the presently-claimed invention. Examiner respectfully disagrees with Applicant's assertion. There is nothing claimed in the *product* portion of the present claims that positively recites anything more than the ink-receiving layer comprising at least one hydrosoluble binder and at least one aluminosilicate polymer. While Application argues that Liu discloses a different product than the product obtained by the specified preparation method that is presently claimed, Applicant has provided no dispositive evidence (i.e., a clear showing that the product produced by the specific process of Liu is different than that which is presently claimed) to support this position. Applicant asserts that a comparison example to a material prepared by a process believed to be *substantially closer* to the invention than the process employed in Liu has been provided, and that it is unjustified to require Applicant to perform *even further testing* of other materials prepared by even further distinguished processes. However, the present claims are drawn to an article/product ("an ink-jet recording element") that

comprises a polymer that is obtained by a specified preparation method (“process”), and “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) (emphasis added). See MPEP §2113.

Terminal Disclaimer

2. The terminal disclaimer filed on March 26, 2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Second Application No. 10/521,348, Third Application No. 10/583,528, Fourth Application No. 10/521,898, and Fifth Application No. 10/521,899 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Application/Control Number: 10/522,006
Art Unit: 1794

Page 4

/Bruce H Hess/

Primary Examiner, Art Unit 1794